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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,170	10/30/2001	Louis B. Rosenberg	IMM1P027B	1999

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EXAMINER	
BRIER, JEFFERY A	

ART UNIT	PAPER NUMBER
2628	

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/004,170	ROSENBERG ET AL.	
	Examiner	Art Unit	
	Jeffery A. Brier	2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *53,55,56,61,66 and 69-101* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *53, 55, 56, 61, 66, and 69-101* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Amendment

1. The amendment filed on 7/17/2006 has been entered. The amendment to claim 55 overcomes the 35 USC 112 second paragraph rejection based upon "the associated graphical environment" set forth in the office action mailed on 3/14/2006.

Response to Arguments

2. Applicant's arguments filed 7/17/2006 concerning the 35 USC 101 rejection have been fully considered but they are not persuasive because the claim term "display" and "displayed" as defined by applicants specification are a broad terms that is not limited to display on display screen 20. See applicants' specification at page 9 lines 15-20 and page 10 lines 3-18.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 53, 55, 56, 61, 66, and 69-101 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In view the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility published on the USPTO website on October 26, 2005,

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

and published in the OG 22Nov2005

http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm.

the following 35 USC 101 rejection is now required because practical application of the claimed filtering is not present in the claims. On pages 20-22 and 37-39 of the pdf version of the Interim Guidelines practical application and useful, tangible, and concrete results are discussed. Claim 53 claims "produce the input data operative to reduce visual disturbance to a user controlled graphical object displayed in the associated graphical environment". Claim 55 claims "produce the filtered input data operative to reduce visual disturbance in the associated graphical environment". Claim 56 claims "produce the input data being operative to reduce visual disturbance to a user controlled graphical object displayed in the associated graphical environment". Claim 61 claims "the filtering of the sensor data operative to reduce visual disturbance to a user controlled graphical object displayed in an associated graphical environment caused by the output of haptic feedback". Claim 66 claims "a filter configured to receive sensor data from the sensor and to provide input data to an associated graphical environment... the filter being configured to reduce undesired display effects associated with force sensation in a graphical environment". Each of these claims fail to claim a real world practical application due to their brevity. In claims 53, 55, 56, and 61 the term phrase "reduce visual disturbance to a user controlled graphical object displayed in an associated graphic environment" does not provide sufficient real world application for the "filtering sensor data" step because the clamed term "displayed" is defined by the specification broadly to be things other than visually displayed on display screen 20. Similarly in claim 66 "to reduce undesired visual display effects" do not give a practical application for the "filter" and the "input data" because the clamed term "display" is

defined by the specification broadly to be things other than visually displayed on display screen 20. Dependent claims 69-77, 79-84, 86-91, 93-98, 100, and 101 do not further define the allege application of the filtered signal. Dependent claims 78, 85, 92, and 99 claim "updating a position of a graphical object in the associated graphical environment based on the input data" which does not correlate the visual disturbance to the graphical object. In claims 53, 55, 56, and 61 and their dependent claims the "filtering sensor data" is not positively correlated to the haptic-feedback device such that a practical application of "filtering sensor data" and the "reduce visual disturbance in the associated graphical environment" is not present. The claimed "graphical environment", "graphical object", and "undesired display effects" needs to be visually displayed on display screen 20. In re Alappat 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994). State Street Bank & Trust Co. v. Signature Financial Group Inc. (CA FC) 47 USPQ2d 1596, 1603 (7/23/1998). AT&T Corp. v. Excel Communications Inc. (CA FC) 50 USPQ2d 1447.

On page 1603 first paragraph the CAFC wrote in State Street:

> Under Benson , this may have been a sufficient indicium of nonstatutory subject matter. However, after Diehr and Alappat , the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a "useful, concrete and tangible result." Alappat , 33 F.3d at 1544, 31 USPQ2d at 1557. 7

On page 1603 paragraph labeled [4] the CAFC wrote:

> [4] The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to 9 -- process, machine, manufacture, or composition of matter--

> but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See In re Warmerdam , 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994).

Therefore the claims need to be amended to clearly claim a practical application of filtering the sensor data generated by the haptic-feedback device while the haptic-feedback device is generating haptic-feedback to the user.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 53, 55, 56, and 69-92 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims 53, 55, and 56 were amended to claim "wherein the filtering input data further includes identifying the visual disturbance in response to the outputting of haptic feedback" while the specification does not describe nor convey "identifying the visual disturbance" but

rather determines the type of haptic feedback and then determines an appropriate disturbance filter. See applicants' specification at page 33 line 1 to page 36 line 23.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 53, 55, 56, 61, 66, and 69-101are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 53, 55, 56, and 61 were amended to claim "user controlled graphical object displayed". Independent claim 66 was amended to claim "to reduce undesired display effects". The scope of the terms "display" and "displayed" are unclear because applicants' specification gives an unclear definition to "displayed". See applicants' specification at page 9 lines 15-20 and page 10 lines 3-18. The specification describes the disturbances that are corrected are visually displayed disturbances, thus, claims to a broad display do not clarify the type of disturbances being corrected by the claimed filtering. See applicants' specification at page 20 lines 30-31, page 22 lines 4-11, page 24 lines 6-15, page 24 line 34 to page 25 line 8, page 26 lines 24-27, and page 31 lines 9-17. In each of the independent claims the location of the graphical environment is not claimed, thus, it may not be visually displayed. Claims 53, 55, 56, and 61 should be amended to clearly claim the "associated graphical environment" and the "graphical object" are visually displayed on display screen 20. Claim 61 at line 4 "the haptic feedback" lacks antecedent basis in the claim since it is different than the previously

claim haptic-feedback due to the lack of the hyphen. Claim 61 at line 5 "sensor data" is also claimed at line 4, thus, in the claim it is not clear if the sensor data at line 5 is the same sensor data at line 4 or different sensor data. Claim 66 should be amended to clearly claim the "associated graphical environment" and "undesired visual display effects" are visually displayed on display screen 20. Dependent claims 69, 72, 73, 78, 79, 82, 85, 86, 89, 90, 92, 93, 96, 97, 99, and 101 also claim "associated graphical environment". Dependent claims 70, 80, and 87 claim sending the input data to a processor, now, due to the claim amendments to their respective parent claims it is not certain whether applicant is claiming the input data is being sent to a processor after or before filtering the input data.

9. A prior art rejection cannot be made because the metes and bounds of the claims are not definite and because the specification does not support the claims. Thus, an indication of allowability would be premature. In re Steele, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffery A Brier
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